

Remarks

The Examiner has rejected claims 1-15 and 17-31 under 35 U.S.C. §103(a) as being unpatentable over Miraglia, U.S. Patent No. 6,481,445 in view of Gueret, U.S. Patent 6,073,634. Claims 16 and 32 are rejected under 35 U.S.C. §103(a) as unpatentable in view of the above references, and further in view of Gueret, U.S. Patent No. 5,063,947. These rejections are respectfully traversed.

The present invention is directed at a mascara brush having a specified combination of bristle diameter, density, and hardness, that is particularly effective for use with higher viscosity mascaras, of 2,000,000 centipoise and above, because it provides an optimum combination that allows a relatively large brush loading with mascara product, combined with an effective combing out of the eyelashes once the mascara is applied.

Claims 1-16 of Applicant's application claim a brush with a plurality of bristles having bristle diameters of about .010 inch to about .016 inch and a durometer of about 92 Shore D to about 120 Rockwell R at a bristle density of about 8 to 20 bristles per turn. . Claims 17-32 of Applicant's application claim a brush with a plurality of bristles having bristle diameters of about .011 inch to about .014 inch a durometer of about 100 to about 120 Rockwell R at a bristle density of about 10 to 15 bristles per turn. The combination of the references does not suggest or disclose Applicant's claimed invention, and the rejections should be withdrawn

The Examiner states in the office action that Miraglia '445 discloses bristles of .008 to .018 inch and a density of 4 to 27 bristles per turn, but that the bristles are soft, in the range of 62D and 82D Shore hardness. The Examiner relies on Gueret '634 for the claimed range of hardness of the bristle element. However, the Gueret '634 patent does not relate to a twisted wire mascara brush as specified in the claims of the present application. The Gueret '634 patent relates to an applicator which in appearance is like

a paint brush, not a twisted wire brush. In the applicator disclosed in the Gueret '634 patent there are bristles that are secured at only one end, instead of in their middle as is specified in the present application. The Gueret '634 brush has relatively longer bristles than a twisted wire brush (the preferred embodiment is specified as having a bristle length of 15-20 mm) (Col 8, line 36). Thus, choices made in connection with the brush design in Gueret '634 do not automatically make them appropriate choices for a twisted wire brush. There are two very different mascara loading and eyelash coating issues to be addressed by the two different designs. In short, it would not have been obvious at the time of the invention to use bristles disclosed in the Gueret '634 patent because it is for a very different type of brush structure than that claimed in the present application.

Furthermore, even if it were appropriate to combine these references (which it is not), the invention still is not made obvious by the combination. Gueret '634 discloses bristles having a durometer of between 10 Shore A to 90 Shore D, and preferably from 30 Shore A to 60 Shore D. Clearly, in the present application a different range of hardness, beginning at 92D Shore and ending at 120R Rockwell is claimed. This is intended to specify a harder bristle than defined by the Gueret '634 patent. It is not the same range, and the presently claimed invention is not obvious in view of this disclosure.

The Examiner refers to Miraglia '445 as providing a conversion between the Shore D and Rockwell R hardness scales. Such conversions are very inaccurate and are not recommended in proper engineering usage. As an example, see the information submitted herewith which was obtained from the www.matweb.com website. As stated therein, "the correlation between the two Shore Durometer hardness scales is weak; attempts at conversion between the scales are therefore discouraged. The correlation is higher for materials with similar resiliency properties, but is still too low for reliable conversions. Likewise, conversion between Shore Hardness and Rockwell hardness is dis-

couraged." As there is a wide error range in attempting conversions between different ranges and it is respectfully submitted that the conversion referenced in the Miraglia '445 patent is erroneous.

The disclosure of Miraglia '445 of ranges of 62D and 82D Shore hardness does not overlap with Applicant's claimed range of about 92D Shore to about 120R Rockwell (or preferably about 100R to about 120R Rockwell).

The disclosure of Gueret '634 of ranges of 10A Shore to 90D Shore (or preferably, 30A Shore to 60D Shore) does not overlap with Applicant's claimed range of about 92D Shore to about 120R Rockwell (or preferably about 100R to about 120R Rockwell).

Neither patent discloses a mascara brush with the very high hardness specified in the claims of the present application. Nor do the references suggest or make obvious the claimed combination of bristle diameter, density and hardness, which provide a twisted wire mascara brush construction with the desired combination of mascara loading and eyelash combing when used with higher viscosity mascara formulations of 2,000,000 centipoise and above

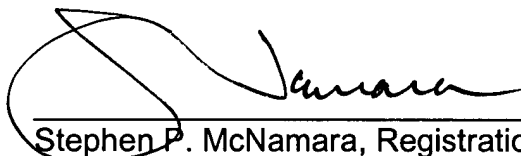
Hence, the combination of Gueret and Miraglia does not disclose, teach, or suggest the combination of elements of Applicant's claims. In order for a combination of references to be properly modified in a rejection under 35 USC 103, there must be some teaching or suggestion in either of the references to make the suggested modification. Absent such teaching or suggestion, there is no motivation for one skilled in the art to make the modification and such modification would be improper. Here there is no such teaching. As noted above, the disclosure of the Gueret '634 patent is not applicable to a twisted wire mascara brush. Even if it were, Gueret '634 already teaches a range of between 10 Shore A to 90 Shore D (and a preferred range of between 30 Shore A to 60 Shore D). There is no teaching or suggestion in Gueret '634 to expand the range outside 90D

Shore, much less substantially outside the upper limit of 92D Shore . Applicant's range starts at about 92D Shore and increases to about 120R Rockwell, which is outside of Gueret's broadest range for bristle hardness. The asserted combination is improper and the rejection of claims 1-15 and 17-31 under 35 U.S.C. §103(a) should be withdrawn.

For the same reasons, the rejection of claims 16 and 32 should also be withdrawn. Furthermore, the asserted combination of Miraglia '445 and Gueret '634 and '947 does not make the invention obvious because Gueret '947 discloses grinding bristle ends to form small "hooks", while the invention claimed in claims 16 and 32 has as an alternative a mechanical splitting of the ends in addition to grinding.

Accordingly, for all of the foregoing reasons, the rejection of claims 1-35 should be withdrawn. It is respectfully requested that a Notice of Allowance be issued in the above application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Stephen P. McNamara', is written over a horizontal line.

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